

Appl. No. 09/589,449

REMARKS

Applicant has reviewed the Office Action of 27 May 2003 and offers the following remarks in response thereto.

Initially, Applicant notes a procedural defect in the Office Action of 27 May 2003. The Office Action Summary page indicates that claims 17 and 18 are rejected. Paragraphs 22 and 23 of the Office Action address claims 17 and 18, but nowhere in the Office Action is there a recitation of the grounds under which claims 17 and 18 are rejected. To this extent, the Office Action is incomplete. Applicant requests clarification and the issuance of a new Office Action resetting the time period for reply at the Examiner's earliest convenience.

Claims 1-4 and 7-10 were rejected under 35 U.S.C. § 103 as being unpatentable over Zhang et al. (hereinafter "Zhang") in view of Cave et al. (hereinafter "Cave"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the combination of references each and every claim element is taught. MPEP § 2143.03.

The Patent Office indicates that Zhang shows substantial features of the claimed invention, but admits that Zhang does not disclose a control protocol message. Implicit in this admission is the fact that since a control protocol message is not taught, translation of a control protocol message is not taught. The Patent Office opines that Cave discloses control protocol messages. The Patent Office then opines that it would have been obvious to modify Zhang to employ the use of control protocol messages.

Assuming, *arguendo*, that Zhang and Cave do teach these elements, the combination of Zhang and Cave does not necessarily show the recited "means for translating an IP address within said control protocol message . . ." (claim 1). To show the recited claim language, Zhang's messages would have to be replaced with Cave's control protocol messages. In other words, Cave's control protocol messages would replace Zhang's messages. The relevant standards for combining references do not allow for this sort of substitution. Specifically, the references must be considered in their entireties. MPEP § 2143.02. The Federal Circuit has interpreted this requirement to consider the references in their entireties as a prohibition against cherry picking elements from references and replacing isolated elements in one reference with isolated elements from a second reference. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The Federal Circuit prohibits such selective extraction on the grounds that such selective extraction

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typically relies on impermissible hindsight reconstruction. *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991).

Since the selective extraction of isolated elements is not allowed, the Patent Office is not allowed to substitute Caye's control protocol messages into Zhang's system. Since this substitution is not allowed, Zhang, by itself, as admitted by the Patent Office, does not show all the claim elements, and the Patent Office has not established *prima facie* obviousness.

Even if this sort of isolated extraction were proper, the substitution is not obvious to one of ordinary skill in the art because the messages are not equivalents such that it is readily apparent how to perform such a substitution. Zhang is a PPP reference (see abstract, lines 2-3). This means that Zhang operates in the transport layers of the stack. In contrast, control protocol messages operate in the application layers of the stack. These different layers operate substantially differently. In the PPP layer, the IP address is a number such as 10.1.2.3, which is converted to a binary number. This address is always in the same place and is easy to locate. In contrast, the control protocol messages have the IP address as text, which is buried in differing portions of the message. Thus, to perform NAT on the message, the message must be parsed, the IP address located, translated, and then reinserted back into the message. Since the messages operate differently in terms of how the address is stored, the substitution is non-obvious. MPEP § 2143.02.

Claims 2-4 depend from claim 1, including all the elements of claim 1, and are not rendered obvious for at least the same reasons that claim 1 is not obvious.

Claim 7 recites "translating the IP address associated with said second IP network included within said control protocol message . . . ." This claim element is analogous to the claim element discussed above with respect to claim 1, and claim 7 is not rendered obvious by the rejection of record for at least the same reasons. Claim 8 depends from claim 7, including all the elements of claim 7, and is not rendered obvious for at least the same reasons that claim 7 is not obvious.

Claim 9 recites "translating the IP address associated with said second IP network included within said control protocol message . . . ." This claim element is analogous to the claim element discussed above with respect to claim 1, and claim 9 is not rendered obvious by the rejection of record for at least the same reasons. Claim 10 depends from claim 9, including

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all the elements of claim 9, and is not rendered obvious for at least the same reasons that claim 9 is not obvious.

Claims 5, 6, and 11-16 were rejected under 35 U.S.C. § 103 as being unpatentable over Zhang in view of Cave and Arrow et al. (hereinafter "Arrow"). Applicant respectfully traverses. The standard for obviousness is set forth above. Further, the rules about selective extraction are also set forth above.

As Applicant has explained above, the combination of Zhang and Cave relies on impermissible hindsight reconstruction, and thus does not render the claims obvious because there is no teaching that the IP addresses within the control protocol messages are translated. Nothing in Arrow cures the problems of the underlying combination.

Claim 5 recites "translating the IP address associated with said second IP network included within said control protocol message . . . ." This language is similar to that used in claim 1, and thus, the combination does not show this element. Claim 6 depends from claim 5, including the limitations thereof, and is not rendered obvious for at least the same reasons that claim 5 is not obvious.

Claim 11 recites "translating IP addresses within said control protocol messages . . . ." This language is analogous to that discussed with respect to claim 1 or claim 5. As explained above, the combination relies on impermissible hindsight reconstruction. Since the combination is improper, the rejection of claim 11 does not establish *prima facie* obviousness. Claim 12 depends from claim 11, including the limitations therein and thus, claim 12 is not rendered obvious for at least the same reasons that claim 11 is not obvious.

Claims 13 and 15 recite "having said server translate IP addresses within said control protocol message . . . ." This language is analogous to that discussed above, and claims 13 and 15 are patentable at least for the same reasons that claim 11 is patentable. Specifically, the combination of Zhang and Cave relies and impermissible hindsight reconstruction. Claim 14 depends from claim 13 and is patentable for at least the same reasons. Claim 16 depends from claim 15 and is patentable for at least the same reasons.

The Patent Office further opines, in the "Response to Arguments" section, that claims 11-16 do not have the server positioned within the network, behind the firewall. Applicant respectfully disagrees. While limitations in the specification are not imported into the claims, the claims must be interpreted in a manner that they are enabled. The specification only shows the

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server 170 behind the firewall 160 (see Figure 2). Since Applicant does not show the server outside the firewall, the only interpretation of the claim that is enabled is the interpretation that places the server inside the firewall. While the Patent Office argues that the claim language does not make this explicit, the interpretation that the Patent Office advances does not fall within a broad reasonable interpretation of the claim language and thus is not permissible.

Claims 17 and 18 are addressed in paragraphs 22 and 23 of the Office Action, but not formally rejected over a particular combination of references. Claims 17 and 18 depend from claim 5 and are patentable at least for the same reasons that claim 5 is patentable.

The Patent Office has relied on impermissible hindsight reconstruction in the combination of Zhang and Cave. Specifically, the selective extraction of an isolated element of Cave and its substitution into Zhang is the sort of selective extraction that is prohibited by *Fine*. Since Zhang and Cave cannot be combined to show the claimed invention, the claims define over the references. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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Date: July 25, 2003  
Attorney Docket: 7000-246

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